REMARKS

Claims 1-50 are pending in the instant application. Claims 1-24 and 42-50 have been withdrawn from consideration pursuant to a restriction requirement. Claims 25-41 stand rejected. Claim 29 is amended herein. Reconsideration of the instant application is respectfully requested in light of this paper and the attached 37 C.F.R. §1.132 Declaration of Dr. Robert Knoll. This paper has inserted no new matter.

I. INFORMATION DISCLOSURE STATEMENT

Applicants note that on the returned form PTO-1449, of Applicants' Information Disclosure Statement stamped as received in Tech. Center R3700 on June 19, 2002, the Examiner has crossed-out references IA, ID, IM, IP, IQ, IR, IS, IT and IZ. The Office Action does not indicate the reason these references were crossed-out.

Applicants state that the cross-out references were supplied with the information disclosure statement when submitted. However, Applicants resubmit herewith a new form PTO -1449 identifying as references JA-JI the references submitted as references IA, ID, IM, IP, IQ, IR, IS, IT and IZ with the Information Disclosure Statement received in Tech. Center R3700 on June 19, 2002. Because copies of these references were submitted with the original Information Disclosure Statement, no fee or statement under 37 C.F.R. §1.97(e) is required for their consideration.

II. REJECTIONS UNDER 35 U.S.C. §112

Claim 29 stands rejected under 35 U.S.C. §112, second paragraph, because the Office does not understand the meaning of the phrase "0.0250.032 inch." Claim 29 has amended to clarify. Applicants respectfully request the withdrawal of this rejection.

III. ART REJECTIONS

Claims 25-28 and 30-41 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,804,016 to Schmidt et al. (Schmidt). Claim 29 stands rejected under 35 U.S.C. §103(a) as unpatentable over Schmidt in view of U.S. Patent No. 5,303,834 to Krishnakumar et al. (Krishnakumar). For the reasons set forth below, Applicants respectfully traverse these rejections.

A. "Finish"

Before addressing the substance of the outstanding rejections, Applicants wish to clarify an apparent misunderstanding of definition of the term "finish" ascribed by the instant application. The second sentence of the second paragraph under section seven (7) of the outstanding Office Action states as follows: "The outer, or 'finish' layer, may be polyethylene terephthalate...." This sentence indicates that the Office interprets the term "finish" to connote the outer layer of the container and the preform from which it is constructed. Applicants respectfully assert that this is not the definition ascribed by the specification of the instant application.

The specification of the instant application teaches that the term "finish" connotes the portion of the container/preform that extends from the support flange to the container/preform opening to form the container/preform mouth. In the depicted embodiments, the finish comprises threads about the exterior thereof. Applicants respectfully assert that the specification supports this definition. (*See, e.g.*, p. 8, line 23 ("narrow finish 12"); p. 9, line 4 ("a wide-mouth finish 30"); p. 9, line 16 ("a wide-mouth finish 48"); p. 9, line 24 ("wide-mouth finish 64"); p. 10, line 2 ("a wide-mouth finish 82"); p. 10, line 10 ("a wide-mouth finish 102"). In the preceding examples, the names of the various "finish" elements have been provided with modifiers to identify the type of finish as either "narrow" or "wide-mouth" to generally indicate the size of the opening created by the finish. If the term "finish" had been intended to identify the outermost layer of the container, then the

modifiers "narrow" and "wide-mouth" would not have been necessary and, indeed, would not have made sense. Moreover, Applicants assert that the following sentence clearly distinguishes the term "finish" from the container's outermost layer:

> As is known to one of ordinary skill in the packaging art, extending the barrier 118 to the uppermost extremity 126 of **the container finish** 102 would completely **detach the inner layer 120 from the outer layer** 122 and allow rather easy separation of the inner and outer layers 120 and 122.

(See, p. 16, lines 17-20)(Emphasis added) This sentence teaches that, in this embodiment of the invention, portions of the finish are comprised of a barrier 118, an inner layer 120 and an outer layer 122. Because the finish comprises at least three layers, including an outer layer, the finish cannot itself constitute the outer layer.

Moreover, the definition ascribed by the specification to the term "finish" is the understanding of those of ordinary skill in the art. Accordingly, Applicants respectfully assert that the term "finish" does not connote the outer layer of the container of the present invention, or the outer layer of the preforms from which they are formed.

B. "Internal"

The last sentence of section seven (7) of the outstanding Office Action states that the "examiner deems 'internal' to mean intermediate." The significance of equating 'internal' and 'intermediate,' is not apparent to Applicants from the outstanding Office Action. However, it is respectfully asserted that a review of the instant application and the primary reference Schmidt indicates that the term "internal," as used by Schmidt cannot be equated to the term "intermediate" as used in the instant application.

The instant application employs the term "intermediate" as part of the element "intermediate layer" used to identify a layer residing between inner and outer layers of polypropylene. By way of example, the specification of the instant application states as follows at page 11, lines 25-27:

> Accordingly, the terms "intermediate layer" will be used herein to generically refer to a layer positioned intermediate of two PP layers in a preform or container and may, although it need not, comprise a barrier layer.

Schmidt employs the term "internal" to reference the void created by the container it describes. For example, at column 5, lines 47-51, Schmidt states:

> The specific panel thickness and stretch ratio selected depend on the dimensions of the bottle, the **internal** pressure, and the processing characteristics (as determined for example by the intrinsic viscosity of the particular materials employed). (Emphasis added)

Accordingly, Applicants respectfully disagree that the term "internal," as used by Schmidt, may be equated to the term "intermediate" as used in the instant application. Clarification is requested.

C. Schmidt

The outstanding Office Action rejects claims 25-28 and 30-41 as anticipated by Schmidt. The rejection focuses only on those elements of Schmidt's teachings necessary to meet the recited elements of Applicants' claims. However, to properly understand the teachings of Schmidt, as they would be understood by one of ordinary skill in the art, it is crucial to understand the problems Schmidt sought to resolve and the solutions Schmidt teaches. Only then can one place themselves in the shoes of the hypothetical one of ordinary skill in the art, as opposed to someone attempting to reconstruct Applicants' claimed invention.

Schmidt is very clear that the described invention attempts to resolve problems in constructing polyethylene terephthalate (PET) multilayer containers designed to resist high

temperatures and pressures. (*See, e.g.* Abstract). Specifically, Schmidt attempts to prevent separation of PET layers from post-consumer PET (PC-PET) layers in containers for high temperature and pressure applications. Schmidt teaches that layer separation may be prevented by using a preform injection process at specific injection pressures and injection rates. As an exemplary embodiment of the PET/PC-PET container achievable through Schmidt's teachings, specific details of a multilayer container, and the preform from which it is constructed, are also described. Schmidt's exemplary embodiment has inner and outer layers of PET and a core layer of PC-PET. This construction may be hereinafter abbreviated as PET/PC-PET/PET.

After completing his explanation of an injection method that will prevent separation of PET layers from PC-PET layers, Schmidt haphazardly suggests that the invention could be practiced with any one of a large number of various materials. Schmidt lists as alternative materials, a majority of the commercially feasible materials for container production. Among those listed materials, Schmidt included polypropylene (PP). In so doing, Schmidt has attempted to suggest that his preform injection method may be used to construct a preform/container from PP instead of PET, but has failed to teach any of the details of a PP embodiment. One of ordinary skill in the art is left without instruction on how to construct the desired container from PP. Claims 25-28 and 30-41 of the instant application stand rejected based on the details of Schmidt's PET preform and the later catch-all inclusion of PP as a possible substitute for the PET in Schmidt's preform injection method to which the invention is truly directed.

Applicants respectfully assert that the outstanding rejection improperly assumes: (1) that the focus of Schmidt's teachings was the specific configuration of the PET embodiment preform/container rather than the injection method used to prevent delamination, (2) that one of ordinary skill in the art reading Schmidt's suggestion of PP as an alternative material would

understand the suggestion to mean using PP in the specific PET configuration rather than using the injection method for injection PP, (3) that the details taught by Schmidt's PET preform/container (e.g. preform dimensions, stretch ratios, etc.) would apply identically to an embodiment substituting PP for PET, and (4) that Schmidt has taught one of ordinary skill in the art how to construct a preform/container of PP according to its invention in order to produce a container that will not suffer from layer separation.

Because Schmidt's invention lies in the injection method rather than the preform construction, one of ordinary skill in the art would understand Schmidt's teaching of PP as an alternative material to suggest using PP in the injection method, not the preform configuration specific to the PET embodiment. Additionally, because the characteristics of PET and PP differ significantly, the dimensional criteria of Schmidt's PET preform would not be understood by one of ordinary skill in the art to apply to the suggested PP embodiment. Since Schmidt does not teach the claimed invention, it cannot anticipate. *See, e.g., Continental Can Co. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1990).

1. Schmidt's Invention Is An Injection Method

Schmidt's objective is to produce a "multilayer plastic container having enhanced strength for high temperature and pressure applications..." (Abstract, lines 1-2). Schmidt accomplishes such a container by using a multilayer construction comprising inner and outer layers of virgin PET (i.e. non-recycled PET) with a core layer of PC-PET sandwiched there between, and a specific preform injection method to make this construction commercially feasible.

To facilitate use in high temper applications, Schmidt comprises the inner and outer layers from a PET having a high intrinsic viscosity (IV), while allowing a thick core layer of less expensive PC-PET to supply the rigidity to the resulting container. (Col. 3, lines 9-12) Schmidt

recognizes that PC-PET typically has an IV lower than that of the high IV inner and outer layers and that layer separation occurs when the layers have an IV difference over a certain magnitude. (Col. 3, lines 13-22). Layer separation, according to Schmidt, "is an important commercial issue for [carbonated soft drink] containers which are stored for extended periods of time." (Col. 3, lines 23-25)

Schmidt then explains that his injection method prevents layer separation in PET/PC-PET/PET containers by using specific preform injection parameters. Specifically, Schmidt states:

> It has been found that the injection molding and/or blow molding process conditions can substantially diminish or completely eliminate the problem of layer separation for IV deltas on the order of 0.10 or more. More specifically, the rate of injection and amount of pressure applied in the preform mold are increased to insure higher levels of layer bonding.

(Col. 3, lines 30-36) Schmidt continues by explaining why this preform injection method overcomes the problems caused by the differences in IV:

> It is hypothesized that increasing the IV delta between the virgin PET and PC-PET alters the melt solubility of the materials sufficiently to reduce molecular migration and chain entanglement at the layer boundary, thus decreasing layer adhesion. The enhanced injection rate and pressure overcomes this problem.

(Col. 3, lines 54-59) The detailed description of the invention confirms that these are the objectives of Schmidt. Specifically, Schmidt states that the:

> preform has a two-material, three-layer (2M, 3L) structure and is substantially amorphous and transparent. The multiple preform layers comprise, in serial order: outer layer 42 of virgin PET, core layer 43 of PC-PET, and inner layer 44 of virgin PET. The virgin PET is a homopolymer, or low copolymer with for example 2% isophthalic acid modifier, having an intrinsic viscosity of about 0.90 dl/g. The PC-PET has an intrinsic viscosity of about 0.70.

(Col. 5, lines 18-25) The clearest statement of Schmidt's invention, however, may be found in his claims. Consistent with his teachings, each and every one of Schmidt's claims is directed to an

injection method. One of ordinary skill in the art would consider these statements in the detailed description as well as the focus of the claims to indicate that the invention is directed to the injection method to accomplish the stated goals. (See, Decl. of Knoll ¶¶8-9)

Thus, Schmidt's teachings are specific to a preform injection method of overcoming problems with PET/PC-PET/PET containers having IV differentials so that commercially feasible high temperature containers may be produced with a core layer of PC-PET. (See, Decl. of Knoll ¶¶8-10) Schmidt teaches that prior problems of delamination may be overcome with his specific preform injection method.

2. The Alternative Materials Are For Use With The Injection Method, Not The Specific Preform/Container Configuration

Upon achieving an understanding of the problem to be solved by Schmidt's invention, and the fact that his resolution is accomplished with a preform injection method, one of ordinary skill in the art is taught by Schmidt's laundry list of alternative materials, that other materials my be used with the injection method described and claimed by Schmidt. (See, Decl. of Knoll ¶12) Schmidt does not teach how. He certainly does not provide any details. (See, Decl. of Knoll ¶12) But the teaching is clear to one of ordinary skill in the art, Schmidt's preform injection method can be used with the listed alternative materials. (See, Decl. of Knoll ¶12)

Schmidt's PET preform/container configurations are merely incidental to his true invention -- the injection method. (See, Decl. of Knoll ¶14) Nowhere does Schmidt teach or suggest to one of ordinary skill in the art that his specific PET preform/container configurations may be constructed from PP, or any of the other materials in Schmidt's laundry list. (See, Decl. of Knoll ¶13) The invention is the injection method, not the preform/container configuration. (See, Decl. of Knoll ¶¶8-

10, 14) One of ordinary skill in the art reading Schmidt would be lead to substitute materials in the injection method -- not the preform/container configuration. (See, Decl. of Knoll ¶13-14)

3. Schmidt's PET Preform Configuration Is Specific To Its PET Material

The first five and one half columns of Schmidt's Detailed Description are dedicated exclusively to a specific configuration of a PET container and its preform. (See, Col. 4, line 65 to Col. 10, line 30) For example, the Detailed Description of Schmidt's specification begins with the following paragraph:

> According to a first embodiment, an injection-molded multilayer preform and method of making the same are illustrated in FIGS. 4-6. The preform may be expanded to form a multilayer pasteurizable carbonated beverage container as illustrated in FIGS. 7-10.

(Col. 4, line 65 to Col. 5, line 2) And continues shortly thereafter with:

> The multiple preform layers comprise, in serial order: outer layer 42 of virgin PET, core layer 43 of PC-PET, and inner layer 44 of virgin PET.

(Col. 5, lines 20-22) When these teachings are taken together, as they must be, it becomes clear to one of ordinary skill in the art that Schmidt's invention is specific to PET. (See, Decl. of Knoll ¶15) Indeed, this is why the alternative materials (relied on by the rejection) are listed as modifications. Schmidt makes clear that the preform configurations described are specific to the end container by stating that "[t]his **particular preform** is designed for making a 1.0 liter pasteurizable carbonated beverage container (as shown in FIG. 8)." (Col. 5, lines 26-28)(Emphasis added) Indeed, the wording chosen by Schmidt (i.e. "[t]his particular preform") indicates that the preform configuration is specific to the configuration of the end container.

The second paragraph of Schmidt's Detailed Description (Col. 5, lines 3-17) describes various physical features of the PET preform with specific reference to the preform depicted in Fig.

4. Many of the physical features described in this paragraph are relied on by the outstanding rejection. Specifically, the rejection states as follows:

> The preform has a flange on the bottom of the neck portion a thickened base and its bottom end is thinner than the upper base-forming portion of the preform (Col. 5, lines 3-18).

(See, Office Action, Section 7, lines 8-10) Thus, the outstanding rejection relies on the teachings of Schmidt's PET preform. (See, Decl. of Knoll ¶16)

The third paragraph of Schmidt's Detailed Description (Col. 5, lines 18-25) again clarifies that the preform is specifically designed to be constructed from PET. Specifically, this paragraph states, in part:

> The multiple preform layers comprise, in serial order: outer layer 42 of virgin PET, core layer 43 of PC-PET, and inner layer 44 of virgin PET.

Having clearly established that the preform configuration detailed by Schmidt is constructed of PET, the fourth paragraph of the Detailed Description (Col. 5, lines 26-51) goes on to describe: (a) various dimensions of the PET preform, (b) the container to be constructed therefrom, and (c) specific relationships between the PET preform and the PET container (e.g. stretch ratios) necessary to produce a container from the PET preform consistent with the objectives of the invention. By employing the reference numbers assigned to the PET preform depicted in Fig. 4, this paragraph reminds one of ordinary skill in the art that the characteristics described therein relate exclusively to the PET preform described in the preceding paragraph. The outstanding rejection relies on the stretch ratios set out in this paragraph. Thus, the rejection relies on teachings of a PET preform for to meet every element of Applicants' claimed invention, except the limitation requiring Applicants' preform to be constructed of PP. The rejection does not rely on teachings of a PP preform. Indeed, there are none.

4. PP Is Not Measured By Intrinsic Viscosity

The very objective of Schmidt's invention is to prevent delamination between layers having different IV. The explanation applies well to PET, but not at all to PP.

IV is a common measurement of PET and is typically identified by a vendor. (See, Decl. of Knoll ¶17) A manufacturer uses the IV measurement to assist it in designing the processing parameters for injection molding and blow molding of PET. (See, Decl. of Knoll ¶17) The method for measuring the IV of a PET is dictated by ASTM 4603. (Exhibit A hereto) ASTM 4603 expressly applies to PET only. It does not apply to PP. Indeed, the container industry does not employ IV measurements of PP in its design of PP containers or the processes by which they are constructed. (See, Decl. of Knoll ¶17) The PP corollary to PET's IV measurement is a Melt Index measurement. (See, Decl. of Knoll ¶17) The Melt Index is dictated by ASTM 1238. (Exhibit B hereto)

One of ordinary skill in the art reviewing Schmidt would not know how or when to apply the teachings of Schmidt to construct a PP preform/container. (See, Decl. of Knoll ¶¶ 18-23) Schmidt is specifically directed to problems in producing containers with layers having a difference in IV greater in magnitude than 010 dl/g. (See, col. 3, lines 12-16) Since one of ordinary skill in the art does not even think of PP in terms of an IV, that person of ordinary skill in the art would not consider Schmidt's invention applicable to PP, despite Schmidt's catch-all inclusion of PP in the laundry list of possible alternative materials. (See, Decl. of Knoll ¶¶ 18-23)

Accordingly, because PP is not measured by IV, one of ordinary skill in the art would not know how to manufacture the high temperature, high pressure container of Schmidt from PP. Schmidt cannot, then, be said to teach the PP preform of the present invention.

5. Schmidt Fails To Teach Any Preform/Container Of PP

Prior to suggesting any alternative materials to PET, Schmidt sends a clear message that it has concluded its discussion of the PET embodiment and will transition to discussing possible alternatives. Specifically, Schmidt states:

> Although particular embodiments of the present invention have been described, various modifications will be readily apparent to a person skilled in the art and are included herein.

(Col. 10, lines 31-34) Only after this transition does Schmidt suggest that PP, among a list of many other materials, may be substituted for PET. The insertion of this suggestion after the transition from the PET embodiment is significant. It indicates that the detailed description of the PET embodiment has concluded and that the suggested alternatives are just that. It also indicates that the detailed description of the PET embodiment may not directly apply to the suggest modifications. Modification may be required to accommodate the alternatives.

Nowhere does Schmidt state that the detailed PET preform/container configuration can be constructed from PP. Certainly, no details of how to accomplish such an alternative embodiment are provided. Indeed, no details at all are provided for constructing a high temperature and high pressure preform or container from PP or any of the other listed alternative materials. (See, Decl. of Knoll ¶20) Schmidt's invention was an injection method -- not the configuration of a preform or a container. Schmidt merely suggests that the alternative materials may be used with his preform injection method. Schmidt certainly does not state that PP can be simply exchanged for PET without any other modifications to the substantial details of the preform and container. (See, Decl. of Knoll ¶20) Rather, Schmidt's entire teaching of a PP embodiment is as follows:

> For example, one or more layers of the preform and container, or portions thereof, can be made of various other polymers, such as polyolefins (e.g. polypropylene and polyethylene)....

(Col. 10, lines 35-37) This statement does not teach a polypropylene preform as claimed by Applicants. This statement, which is relied on by the outstanding rejection, is nothing more than a portion of a veritable laundry list of those polymers finding use in the packaging industry. It is improper to focus the rejection on just the recitation of PP. In full, Schmidt recites the following for alternative materials:

> For example, one or more layers of the preform and container, or portions thereof, can be made of various other polymers, such as polyolefins (e.g., polypropylene and polyethylene), polyvinyl chloride, polyarcylate, etc. Suitable polyesters include homopolymers, copolymers or blends of polyethylene terephthalate (PET), polybutylene terephthalate (PBT), polypropylene terephthalate (PPT), polyethylene napthalate (PEN), and a cyclohexane dimethanol/PET copolymer, known as PETG (available from Eastman Chemical Company, Kingsport, Tenn.). Polyesters based on terephthalic or isophthalic acid are commercially available and convenient. The hydroxy compounds are typically ethylene glycol and 1,4-di-(hydroxy methyl)-cyclohexane. In general, the phthalate polyester may include polymer linkages, side chains, and end groups not related to the formal precursors of a simple phthalate polyester previously specified. Conveniently, at least 90 mole percent will be terephthalic acid and at least 90 mole percent an aliphatic glycol or glycols, especially ethylene glycol.

(Col. 10, lines 35-54) The remainder of this laundry list must also be considered in order to put Schmidt's teachings in their appropriate context and to provide the understanding that would be taken by one of ordinary skill in the art. Focusing only on the recitation of PP, while turning a blind eye to the other listed alternatives, improperly distorts the true teachings of Schmidt as would be understood by one of ordinary skill in the art. The teachings of Schmidt must be viewed as a whole.

Schmidt details nothing about dimensions, contours or stretch ratios necessary for any of these materials or even provides general suggestions of modifications necessary to accommodate the PP material to achieve the objectives of the invention. (See, Decl. of Knoll ¶20) Because

Schmidt teaches nothing of how to construct a preform or container from PP, it fails to teach the claimed invention.

The outstanding rejection relies on an unsupported and unstated assumption that Schmidt's teachings of the PET embodiment apply equally to an alternate embodiment PP preform. Applicants respectfully assert that they do not. More importantly, however, nowhere does Schmidt state, or even suggest, that PP may be substituted for the PET without any alteration to the detailed configuration of the PET preform or container to accommodate the differences in the materials. (See, Decl. of Knoll ¶20) To the contrary, Schmidt itself recognizes the importance of a polymer's characteristics to its processability.

"The intrinsic viscosity (I.V.) effects the processability of the resins."

(Emphasis added) (Col. 11, lines 45-46) As Schmidt here recognizes, differences in material properties cause materials to behave differently. Thus, the material characteristics are important to achieving Schmidt's high temperature, pressure container and must be considered in the construction of the preform/container as well as the processes for constructing them.

Assuming, for arguments sake, that one of ordinary skill in the art would seek to construct a PP container comporting with the teachings of Schmidt, that person of ordinary skill would not produce a PP preform having the same detailed configuration as the PET preform. (See, Decl. of Knoll ¶21) Rather, the differences in the material properties of PET and PP would steer that person of ordinary skill to modify the size, shape, thickness, etc. of the preform or container to accommodate the differences in material properties. (See, Decl. of Knoll ¶21)

Case-in-point, intrinsic viscosity. As cited above, Schmidt itself teaches that the intrinsic viscosity of polymers affects their processability. Since a polymer's intrinsic viscosity affects it

processability, changing the polymer employed for Schmidt's primary embodiment preform will necessarily result in a change in how the preform performs under injection molding and stretch blow molding, if the polymers have different intrinsic viscosities. One of ordinary skill in the art would understand that changing the PET of Schmidt's preform to PP would require corresponding changes in the configuration of the PP preform to accommodate the changes in material properties. (See, Decl. of Knoll ¶21) For example, PP possesses very different characteristics than does PET causing PP to behave differently when subjected to stretch blowmolding. By way of example only: (1) PP has a tensile strength of about 2990 to 5260 psi whereas PET has a tensile strength of about 6680 psi, and (2) PP has a modulus of elasticity of about 156 to 185 Kpsi whereas PET has a modulus of elasticity of about 484 Kpsi. These are very important characteristics of a polymer that must be considered when designing a preform for injection and later blow molding into a container. (See, Decl. of Knoll ¶22) Also important, as cited above, is the IV measurement of a PET and the corresponding Melt Index of a PP, to which Applicants are not aware of a conversion. (See, Decl. of Knoll ¶22)

For these reasons, one of ordinary skill in the art would modify the configuration of the PET preform detailed by Schmidt when changing the material to PP. (See, Decl. of Knoll ¶23) In order to achieve the container that is the objective of Schmidt, one of ordinary skill in the art would understand that the configuration of Schmidt's PET preform would require modification commensurate with the changes in material, including the changes in processability expressly recognized by Schmidt as important. (See, Decl. of Knoll ¶23)

To anticipate the pending claims, Schmidt must teach each and every element of those claims sufficiently to have placed a person of ordinary skill in the art in possession of the claimed invention. *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990). Absent such a teaching, Schmidt cannot

anticipate the pending claims. *Id.* Schmidt fails to teach one of ordinary skill in the art that the PET preform taught by Schmidt may be constructed from PP to blow a PP container without modifying the specified configuration of the PET preform relied on by the rejection. Accordingly, Schmidt does not enable, and thus cannot anticipate, the invention of claims 25-28 and 30-41of the instant application.

6. Unobviousness

Nor would it have been obvious to combine the PET teachings of Schmidt with Schmidt's identification of PP as an alternative. First, as stated above, one of ordinary skill in the art would not have constructed the PET preform of Schmidt from PP because that person of ordinary skill in the art would have understood that a change of material would dictate other changes in the preform as well (e.g. dimension, stretch ratio) to achieve the objectives of Schmidt.

Second, Schmidt provides no motivation to combine the PP teaching of Schmidt with the configuration of the PET preform without making changes to the preform configuration on which the rejection relies. "[T]he mere fact that teachings found in the prior art could be combined as proposed by an examiner does not make the combination obvious 'absent some teaching, suggestion or incentive supporting the combination.'" *Ex Parte Metcalf*, 67 USPQ2d 1633, 1635 (Bd. Pat. App. & Int., 2003)(*citing Carella v. Starlight Archery and Pro Line Co.*, 231 USPQ 644, 647 (Fed. Cir. 1986)). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *Id.* Rather, Schmidt actually teaches away from substituting PP for PET without modification to the preform modification. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be...led in a direction divergent from the path that was taken by" the instant application. *Tec Air, Inc. v.*

Denso Mfg. Michigan Inc., 52 USPQ2d 1294, ___ (Fed. Cir. 1999)(*citing In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994)). Schmidt's teachings that processability is affected by the particulars of the material employed actually teaches away from substituting PP for the PET from which Schmidt constructed the PET preform without modifying the preform configuration detailed by Schmidt.

CONCLUSION

Applicants assert that this application is in condition for allowance. Early action to that end is requested.

A Declaration of Dr. Robert Knoll under 37 C.F.R. §1.132 is submitted herewith in support of this paper.

Respectfully submitted,

McDERMOTT, WILL & EMERY

Date: November 10, 2003

Matthew E. Leno
Registration No. 41,149
Attorney for Applicant

McDERMOTT, WILL & EMERY
227 West Monroe Street
Chicago, Illinois 60606-5096
Telephone: (312) 372-2000